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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/789,104      | 02/27/2004  | Jared Ross Van Orman | JV03-01             | 7677             |

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02/05/2007

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| EXAMINER |
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JIMENEZ, MARC QUEMUEL

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3726

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/05/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/789,104

Applicant(s)

VAN ORMAN ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-14 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 and 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2-27-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II in the reply filed on 1-22-07 is acknowledged. Applicant has canceled the non-elected claims.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (elected method claims).
3. The use of the trademark CERMARK has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 22** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The use of titanium dioxide as the metal marking layer is considered new matter. Although, titanium dioxide is disclosed to be used in the prior art, there is no support for the instant invention to use titanium dioxide for the metal marking layer.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 8-14 and 21-33** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "sheet metal" in line 5 which lacks proper antecedent basis.

Claim 27 recites "sheet metal" in line 6 which lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. **Claims 8, 11-14 and 23** are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (hereinafter APA, see figures 1-4 of applicant's specification, labeled "PRIOR ART") APA teaches in figures 1-4 of applicant's specification, a method of manufacturing a bracelet, comprising the steps of: cutting a laminar metal strip **101** to a desired length and width, the laminar metal strip **101** having first and second parallel, opposed, generally planar major surfaces, coating at least the first major surface with a metal marking layer **201**, subjecting the coated piece of sheet metal **101** to a laser beam (figure 3), whereby heat generated by the laser beam causes selected regions of the metal marking layer **201** to form at least one ceramic design **301** that is adhered to at least the first major surface, removing all portions **302** of the marking layer that has not been treated by the laser beam and adhered to the first major surface, bending the metal strip **101** to form a bracelet having a general C-shaped side profile, and wherein the first and second major planar surfaces are transformed to curvilinear surfaces. Although it is not shown, it is inherent that the flat strip **101** is bent because bracelets have a curved shape. The specific materials of the marking layer claimed can be found on page 6, first full paragraph of applicant's specification.

10. **Claim 10** is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over APA.

It is inherent that a table is used under the metal strip shown in figure 3 during laser emission. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 9 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Robertson (US5855969).

APA teaches the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA with a laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

APA does not specifically disclose that the marking layer comprises titanium dioxide.

Robertson teaches using titanium dioxide (col. 5, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA with titanium dioxide in the marking layer, in light of the teachings of Robertson, in order to provide a material that effectively creates a marking when subjected to lasers.

13. **Claims 21 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over APA.

APA does not specifically disclose coating both sides of the metal strip. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color. Furthermore, the particular thickness of the coating is considered an obvious matter of design choice to a person of ordinary skill in the art, at the time of the invention, depending upon the desired coating material that is used. In addition, official notice is taken that the use of the claimed thicknesses are well known to a person of ordinary skill in the art.

14. **Claims 25, 27 and 30-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Barr (US5586390).

APA does not specifically disclose rounding any square corners.

Barr teaches rounding any square corners to form rounded ones **36,35**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA with rounding any square corners, in light of the teachings of Barr, in order to provide a desired bracelet design. APA does not specifically

disclose coating both sides of the metal strip. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have coated both sides of a metal strip in order to create a bracelet that has a consistent design and color.

15. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Shapiro (US1634562).

APA does not specifically disclose using rollers to bend the strip.

Shapiro teaches that it is known to use rollers **45,46** to bend (figure 11).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided rollers to bend the metal strip, in order to create a symmetrically shaped jewelry article.

16. **Claims 28-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Barr as applied to claim 27 above, and further in view of Robertson.

APA/Barr teaches the invention cited above with the exception of specifically disclosing that the laser system moves in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface.

Robertson teaches a computer controlled **30** raster-scanning infrared energy emitting carbon dioxide laser system that scans in a Y-axis direction and moves in an X-axis direction as it directs energy on a planer major surface (see entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of APA/Barr with a laser system moves in a Y-axis



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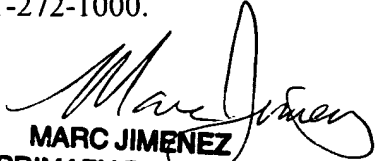
direction and moves in an X-axis direction as it directs energy on a planer major surface, in light of the teachings of Robertson, in order to provide an accurate and automated laser marking system.

It is inherent that a table is used under the metal strip shown in figure 3 of APA during laser emission. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided a positioning table, in order to support the metal strip during laser processing.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
MARC JIMENEZ  
PRIMARY EXAMINER  
1-26-07